

REMARKS

Claims 20-57 were rejected. Claims 20-21, 33-34, 39-40, 48, and 53 have been amended. Claims 22-24 and 41-43 have been canceled. Claims 20-21, 25-40, and 44-57 are now pending. The above amendments and the following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance.

Specification

The Examiner objected to the specification, contending that it failed to provide proper antecedent basis for the claimed subject matter—particularly, the terms “spectral weighting” (claims 33-36, 38, 52-55, and 57) and “resistor” (claims 36-37 and 55-56). As indicated above, Applicants have amended the specification to provide antecedent basis for the terms in question. Accordingly, Applicants request withdrawal of the objection.

Claim objections

The Examiner objected to claims 34 and 53, contending that the term “the weighting curve” lacked proper antecedent basis. Further, the Examiner objected to claims 41-43, 48, and 53, contending that the claims are directed towards an arrangement but do not further limit the structure of the apparatus.

Applicants have amended claims 34 and 53 to overcome the objection. It should be noted that a weighting curve is a graph well known by those of ordinary skill in the art. Applicants canceled claims 41-43 and amended claims 48 and 53 to overcome the remaining objections. Accordingly, Applicants request withdrawal of the objections.

Rejection of claims 20 and 39 pursuant to 35 U.S.C. § 112

The Examiner rejected claims 20 and 39 pursuant to 35 U.S.C. § 112, second paragraph, contending that the claims were indefinite. Applicants have amended the claims to overcome the rejections. Accordingly, Applicants request withdrawal of the rejections.

Rejections of claims 20, 23-25, 27, 30-32, 39, 42-44, 49-51, 55 and 56 pursuant to 35 U.S.C. § 102(e)

The Examiner rejected claims 20, 23-25, 27, 30-32, 39, 42-44, 49-51, 55 and 56 pursuant to 35 U.S.C. § 102 as being anticipated by U.S. Pat. No. 6,858,852 to Wolleschensky, et al. (“Wolleschensky”).

Wolleschensky discloses a method for operation of an image-generating optical system for detection of characteristic quantities of the wavelength-dependent behavior of an illuminated specimen. Wolleschensky, however, does not disclose that “the samples are measured sequentially in microtiter plates,” as required by amended independent claims 20 and 39. Further, Wolleschensky does not disclose “providing ... at least one standard sample” or “recording a spectrum of the at least one standard sample,” as also required by claims 20 and 39. These limitations were incorporated from dependent claims 21-22 and 40-41, respectively. In the previous Office Action, the Examiner did not contend that Wolleschensky disclosed these limitations, and a review of the reference reveals that Wolleschensky in fact does not disclose these limitations. Thus, Wolleschensky does not disclose each limitation of independent claims 20 and 39, and therefore Wolleschensky cannot anticipate claim 20 or 39 or their dependent claims. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejections of claims 21-22, 26, 28-29, 33-38, 40-41, 45-48, 52-54, and 57 pursuant to 35 U.S.C. § 103(a)

The Examiner rejected claims 21-22, 26, 28-29, 33-38, 40-41, 45-48, 52-54, and 57 pursuant to 35 U.S.C. § 103(a) as being unpatentable over Wolleschensky in view of numerous other references.

35 U.S.C. 103(c)(1) provides:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

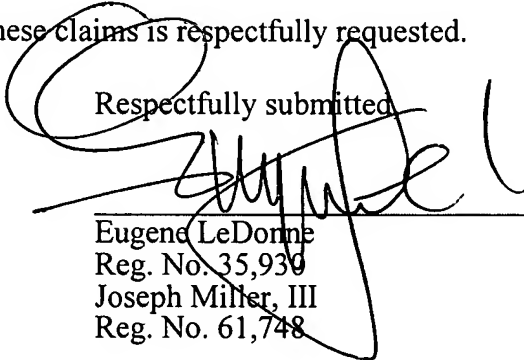
The Examiner contends that Wolleschensky qualifies as prior art pursuant to 35 U.S.C. § 102(a) and 102(e). Wolleschensky, however, does not qualify as prior art pursuant to section 102(a). Wolleschensky's 102(a) date is February 21, 2002, the date of its publication. The instant application, however, claims priority to German application 102 00 499.4, which was filed on January 3, 2002. Because the date of invention for the current application predates the 102(a) date of Wolleschensky, Wolleschensky only qualifies as prior art pursuant to section 102(e).

Serial No.: 10/500,648

Further, at the time the current invention was made, Wolleschensky and the current invention were both owned by, or subject to an assignment to Carl Zeiss Jena GmbH. Thus, pursuant to 35 U.S.C. 103(c), Wolleschensky is not available as a 103 reference. Accordingly, Applicants respectfully request withdrawal of the rejection.

An early action on the merits of these claims is respectfully requested.

Respectfully submitted,



Eugene LeDorne
Reg. No. 35,930
Joseph Miller, III
Reg. No. 61,748

REED SMITH LLP
599 Lexington Avenue
29th Floor
New York, NY 10022
(P) 212-521-5400

Attorney for Applicant